

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/631,810

Atty Docket No.: Q76527

REMARKS

The Office Action of October 7, 2004 has been received, and its contents have been carefully considered.

Claims 1 to 8 are all the claims pending in the application.

The Examiner acknowledges applicants' election of Group I, claims 3 to 8.

The Examiner states that claims 1 and 2 are drawn to tricyclic rings, because Z_2 is directed to specific 5-membered rings.

The Examiner states that Z_2 (of formula (III) of claim 1) is not permitted to be a benzothiophene or benzofuran ring as stated in the restriction requirement.

This position of the Examiner seems to be different from the Examiner's original interpretation of claims 1 and 2. Thus, in the restriction requirement of August 18, 2004, the Examiner included "Claims 1-8 (in part)" in Group I, "drawn to [a] tetracyclic ring".

Accordingly, at the time of the restriction requirement, the Examiner apparently recognized that claim 1 was broad enough to cover tetracyclic compounds. In any event, applicants have amended claim 1 as set forth above to direct it to a tetracyclic ring system. As amended above, applicants submit that claim 1 should be examined with claims 3 to 8 of Group I because claim 1 is broad enough to read on the elected Group I where V_2 and V_3 form a benzo ring. Thus, in claim 1 as amended above, Z_2 can contain a benzo ring or another ring with the furan ring or thiophene ring.

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Claims 3 to 8 have been rejected under the second paragraph of 35 U.S.C. § 112 as indefinite. The Examiner sets forth three reasons for this rejection. Applicants discuss each of these reasons below.

(a) The Examiner states that claim 3 is indefinite because it improperly depends on claim 1.

The Examiner states that claim 3 is drawn to a tetracyclic ring, that is, V_1 and V_2 form a benzo ring, in accordance with the restriction requirement and the election of Group I.

The Examiner states further that claim 1 is withdrawn from prosecution because it is drawn to tricyclic rings. The Examiner refers to Group II of the restriction requirement.

This rejection results from the Examiner's interpretation that claim 1 is limited to tricyclic rings.

As discussed above, applicants have amended claim 1 to direct it to a tetracyclic condensed ring system. Accordingly, applicants submit that claim 3 properly depends from claim 1.

(b) The Examiner states that in claim 3 and elsewhere in the claims, the phrases " V_1 represents a substituent" are indefinite. The Examiner asks what substituents, and asks what substituents are covered and what are not.

In response, applicants submit that the mere use of the term "substituent" or substituted" does not render a claim indefinite, and that there is no requirement that a claim set forth specific substituents. See, for example, *Ex parte Altermatt*, 183 USPQ 436 (Bd Pat App & Int 1974)

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where the term “substituted” was held to be not indefinite. See also *Hawley’s Condensed Chemical Dictionary*, 14th Ed., where the term substituent is defined as “[a]n atom or radical that replaces another in a molecule as the result of a reaction”, and *In re Mertens*, 74 USPQ 311 (Bd. Pat. App. & Int. 1947) where the term “substituent” was recognized “in chemical parlance” to mean “ordinarily either an atom or a radical which enters into the structure of a molecule and replaces another atom or radical”.

A feature of the compound of the present invention that is recited in claim 3 is the thiazole ring formed by Z_3 or Z_5 condensed to a benzene ring to form a condensed thiazole, and the specific 5-membered hereto ring (Z_4 or Z_6) condensed to the benzene ring.

A substituent V_1 which may further be present in the above referred to benzene ring may be any one which can be substituted chemically. Applicants submit that this can be easily understood by one skilled in the art. See the description of V_1 at page 23, which states that the substituents described in the definition of V can be exemplified as examples of the substituents V_1 , and the description of V at pages 19 +, where it is stated that the substituent represented by V is not particularly restricted and where numerous examples are then set forth.

Accordingly, applicants submit that the claims of the present application are clear and, therefore, it is not necessary for the claims to contain a specific recitation setting forth specific substituents.

In view of the above, applicants request withdrawal of this rejection.

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(c) Claims 5, 6 and 8 have been rejected because they contain the phrase “dissociable group”. The Examiner asks what groups are covered and what are not covered by this term. The Examiner states that the claims recite at least one dissociable group that are contained in the substituents substituted on the heterocyclic group represented by Z_2 (i.e., a sulfo or a carboxyl group), but applicants do not recite other dissociable groups that applicants intend to claim. The Examiner asks what are the other dissociable groups, and what does the term actually mean. The Examiner states that the term “dissociable group” is not standard nomenclature.

In response, applicants point out that according to *Hawley's Condensed Chemical Dictionary*, 14th Edition, the term “dissociation” (copy attached) generally means a process by which a chemical combination breaks up into simpler constituents as a result of either added energy, as in the case of gaseous molecules dissociated by heat, or the effect of a solvent on a dissolved polar compound (electrolytic dissociation). It can be the breaking up of the molecule into 2 or more negatively or positively charged components. Thus, applicants submit that one of ordinary skill in the art would understand that a “dissociable group” means a group which is broken off from the remainder of the compound.

Applicants point out further that claims 5, 6 and 8 state that the dissociable group “has a dissociable proton and has a negative charge at proton dissociation or forms a salt with a counter cation in the form of an anion”.

In view of the above, applicants request withdrawal of this rejection.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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